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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,998	03/02/2004	Joseph S. Ng	04-0143	4304
74576	7590	09/02/2009		
HUGH P. GORTLER			EXAMINER	
23 Arivo Drive			PLUCINSKI, JAMESUE A	
Mission Viejo, CA 92692				
		ART UNIT	PAPER NUMBER	
		3629		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/791,998

**Applicant(s)**

NG ET AL.

**Examiner**

JAMISUE A. PLUCINSKI

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/24/09 has been entered.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. With respect to Claims 32 and 33: The claims are directed towards a system, which is considered to be an apparatus claim, with structural elements. The claims contain structural limitations, however positively claim active method steps of "operating" and "switching". Therefore it is unclear to the examiner if this is a system claim or a method claim. The applicant suggests the wording "the CSU is configured to operate in a high power".

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 27 is rejected under 35 U.S.C. 102(e) as being anticipated by Webb, Sr. (US 2004/0257225).

7. With respect to Claim 27: Webb discloses the use of a system for maintaining security of a cargo container during shipment from an origination point to a destination (See abstract) comprising:

- a. Means for determining geographic location of the cargo container during shipment from the origination point to the destination (Reference numerals 142, 241 with corresponding detailed descriptions and Paragraphs 0056 and 0057); and
- b. A battery-powered (paragraph 0069) container security unit (200) for the container, the CSU reporting on status of the cargo container during the shipment (Reference numerals 270, 237 and Paragraph 0068). Webb discloses reporting and transmitting the data periodically and transmits only within range of the satellite, (Paragraphs 0073, 0078, 0084 and 0098), however the reporting being done on a frequency that is a function of the geographic location of the container, in considered to be intended use system. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed

apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPW2d 1647 (1987), *In re Paulsen*, 30 F. 3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994). The claim is directed to a system, which is in essence an apparatus claim, which is held to the structural limitations. Webb discloses all the structural limitations of the claim, therefore anticipates Claim 27.

8. Claims 27-31 are rejected under 35 U.S.C. 102(c) as being anticipated by Peel et al. (Us 2008/0117040).
9. With respect to Claim 27: Peel discloses the use of a system for maintaining security of a cargo container during shipment from an origination point to a destination (see abstract), the system comprising:
  - c. Means for determining geographic location of the cargo container during shipment from the origination point to the destination (See Reference numeral 100 with corresponding detailed description); and
  - d. A battery powered (paragraph 0120) container security unit for the container, the CSU reporting on status of the cargo container during the shipment (See Reference numerals 190 and Paragraphs 0046 and 0076). The reporting being done on a frequency that is a function of the geographic location of the container, in considered to be intended use system. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPW2d 1647 (1987), *In re Paulsen*, 30 F. 3d 1475, 31 USPQ 2d 1671 (Fed. Cir.

1994). The claim is directed to a system, which is in essence an apparatus claim, which is held to the structural limitations. Peel discloses all the structural limitations of the claim, therefore anticipates Claim 27.

10. With respect to Claim 28: Peel discloses the use of a CSU bridge Reference numeral 180 with corresponding detailed description). With respect to the term “for extending range of the wireless network communication so the CSU can operate longer in a low-power wireless network mode”, what the CSU bride is used for considered to be intended use of the CSU bridge. Peel discloses the CSU to be battery powered or solar powered, therefore due to the fact that the present invention considers battery powered to be a lower power environment, then the examiner considers the battery power CSU of Peel to be a low powered environment.

11. With respect to Claims 29 and 30: Peel discloses the Bridge being located on the ship which moves the cargo and communicates via satellite on the water, therefore attached to the moving cargo means and in a location where direct communication links are not available (See Figures 1 and 2 with corresponding detailed description).

12. With respect to Claim 31: Peel discloses, in paragraph 0053, there is two way communication between the CSU bridge and the CSU, therefore fully capable of providing information to the CSU, what that information is regarding, whether it be positional information or not, is considered to be intended use of the system. Systems are held to the structural limitations and the capabilities thereof and it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex*

*parte Masham*, 2 USPW2d 1647 (1987), *In re Paulsen*, 30 F. 3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peel et al. (US 2008/0117040) in view of Koenck et al. (US 2004/0182936).

16. With respect to Claims 32 and 33: Peel discloses the use of a system for maintaining security of a cargo container during shipment from an origination point to a destination (see abstract), the system comprising:

- e. A device for determining geographic location of the cargo container during shipment from the origination point to the destination (See Reference numeral 100 with corresponding detailed description); and
  - f. A battery powered (paragraph 0120) container security unit for the container, the CSU reporting on status of the cargo container during the shipment (See Reference numerals 190 and Paragraphs 0046 and 0076). The reporting being done on a frequency that is a function of the geographic location of the container, in considered to be intended use system. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987), *In re Paulsen*, 30 F. 3d 1475, 31 USPQ 2d 1671 (Fed. Cir. 1994). The claim is directed to a system, which is in essence an apparatus claim, which is held to the structural limitations. Peel discloses all the structural limitations of the claim, therefore anticipates Claim 32.
17. Peel discloses the use of a CSU however fails to disclose the CSU operating in a high power and a lower power wireless state. Koenck discloses the use of a transmitter on a shipping container (see abstract and paragraph 0102), where the transmitter operates in both a high power setting and a low power wireless setting. The high power is used for long range transmissions, where the low power is used for close in transmissions (See Paragraphs 0044, 0047, 0077 and 0091). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Peel, to have the capability to communicate in both low power and high power based on location, as disclosed in Koenck, in order to provide an integrated



communication means which increases efficiency in data collection and improves the functionality of the transmitting/communicating means (See Koenck, Page 2).

***Response to Arguments***

18. Applicant's arguments filed 6/24/09 have been fully considered but they are not persuasive.

19. With respect to Applicant's argument that the CSU of Webb and Peel does not disclose the frequency of reporting is a function of geographical location: The applicant has stated that there is no legal basis for the examiner to state that the limitation is intended use and the claim has been ignored. The claim limitation is not been ignored and it has been addressed. The applicant has claimed a system claim, which are held to the structural limitations and the functionalities which are positively claimed. The CSU of Webb and Peel have a frequency of reporting, therefore provide the functionalities of the apparatus, however in a system claim, the frequency of the reporting does not structurally affect the system. Therefore is related to the intended use the system.

20. With respect to the Applicant's argument that Peel does not disclose the use of a bridge: As stated by the applicant the definition of a term can be given the broadest reasonable interpretation consistent with the specification. And as stated by the Applicant Peel discloses the bridge being located on the ship which moves the cargo containers, and this is acknowledged by the examiner in Claims 29 and 30. The claim is directed towards the system, not the cargo container itself. The examiner considers the ship with the bridge to be part of the system,

therefore the system comprises a bridge, and the examiner's interpretation is consistent with the specification.

21. With respect to the Applicant's arguments in terms of the newly added Claims 32 and 33: The arguments are moot in view of the new rejection outlined above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/

Art Unit: 3629

Primary Examiner, Art Unit 3629